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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,051	06/21/2000	Michael J. Witz	2043.197US1	7802
49845	7590	09/25/2006		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
			EXAMINER KESACK, DANIEL	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>•Application No.</b>		<b>Applicant(s)</b>	
	09/599,051		WITZ ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dan Kesack		3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Amendment filed June 29, 2006 has been entered and fully considered. Amended claims 1 and 4, original claims 2, 3, and 5-12, and withdrawn claims 13-21 are currently pending.

### ***Election/Restrictions***

2. Claims 13-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 29, 2006.

### ***Claim Rejections - 35 USC § 112***

The rejection of claims 1 and 4 under 35 U.S.C. 112, second paragraph, has been withdrawn as a result of Applicant's amendment of claim 1. Examiner has considered Applicant's comments regarding the rejection, and appreciates Applicant's perspective.

Examination of applications is performed by examiners under the guidelines of the MPEP. However, as one can appreciate, the MPEP does not provide reference

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specific documentation as to what phrases or clauses are acceptable, and which are not. A portion of the MPEP relied upon for this reasoning is provided below (MPEP 2171):

The first requirement is a subjective one because it is dependent on what the applicants for a patent regard as their invention. The second requirement is an objective one because it is not dependent on the views of applicant or any particular individual, but is evaluated in the context of whether the claim is definite — i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

Although an essential purpose of the examination process is to determine whether or not the claims define an invention that is both novel and nonobvious over the prior art, another essential purpose of patent examination is to determine whether or not the claims are precise, clear, correct, and unambiguous. The uncertainties of claim scope should be removed, as much as possible, during the examination process.

The inquiry during examination is patentability of the invention as applicant regards it. If the claims do not particularly point out and distinctly claim that which applicants regard as their invention, the appropriate action by the examiner is to reject the claims under 35 U.S.C. 112, second paragraph. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). If a rejection is based on 35 U.S.C. 112, second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984).

Examiner respectfully points out that examiners interpret the claim language in light of the specification, without reading limitations into the claim. Therefore, the application of 35 U.S.C. 112, second paragraph, is always in the context of both the claim language and the specification.

As applied in the previous Office Action, Examiner felt the phrase “associated with” was ambiguous as it related to the present invention. Examiner contemplated multiple interpretations of “associated with”, each of which changed the scope of the claim, in light of the specification. Examiner believes the claim language was not clear to one of ordinary skill in the art as to the patent protection desired. Therefore, in the

interest of compact prosecution, and in determination of patentability over the prior art, Examiner respectfully believes the rejection, in this specific instance, to be appropriate.

Applicant's amendment has made clear this ambiguity, and Examiner respectfully thanks the Applicant for amending the claim, in the interest of expediting prosecution.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3 remain rejected under 35 U.S.C. 102(e) as being anticipated by Reese, as cited in the previous Office Action.

Claim 1 has been amended to recite, "wherein the preference from the user is a selection of an investment or an allocation for the investment that the user provides to the virtual community." This limitation is taught by Reese (column 12 lines 11-16, 35-38, and figure 7).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 8-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, as cited in the previous Office Action.
7. Claims 4 and 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, in view of Segal, as cited in the previous Office Action.
8. Claim 6 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, in view of Phillips, as cited in the previous Office Action.
9. Claim 7 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Reese, in view of Wallman, as cited in the previous Office Action.

***Response to Arguments***

10. Applicant's arguments filed June 29, 2006 have been fully considered but they are not persuasive.

In the previous Office Action, Examiner cited column 12 lines 11-16, 35-38, and figure 7 for teaching “an indication of a preference of a user from a first population of users wherein the first population of users is associated with investment analysis.” The claimed “first population of users” are interpreted by the Examiner to be inherent within this citation, as being those analysts who make the recommendations through the recommendation sources, wherein these sources include online sources, whose recommendations are provided to the “virtual community” of readers. Examiner asserts that the prior art meets the claim language of the first population of users being identified as analysts.

Furthermore, Reese teaches deriving a financial product for a second population of users in response to the set of preferences. In response to Applicant's argument that Reese does not teach deriving a financial product for a second population of users, it is noted that the features on which the applicant relies (i.e. “entirely new”) are not recited in the rejected claims.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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